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EXAMINER

TAYLOR, BARRY W

ART UNIT PAPER NUMBER

2643

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,933

Applicant(s)

LUND ET AL.

Examiner

Barry W. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 36, 37, 40, 41, 43, 44 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 38, 39, 42 and 45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 36 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner is unable to determine from the originally filed specification as to how one of ordinary skill in the art would be able to make and use the invention. The specification provides no basis for the claimed subject matter. Specifically, as by way of example, claim 36 recites, "wherein the location code has not previously been correlated with the physical port". The Examiner is unable to find support for Applicants newly added claim. Another example, claim 43 generally recites, "wherein the subscriber unit is equipped to receive information including voice, video and data content". The Examiner is unable to find support for Applicants newly added claim.

Election/Restrictions

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2. Newly submitted claims 38, 39, 42 and 45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: originally filed claims 1-4 are directed towards correlating a subscriber unit wherein an installer is prompted for location code having classification of class 379, subclass 21 which is completely unrelated to claims 38, 39, 42 and 45 which are directed towards an optical network having classification of class 398, subclass 25 or subclass 168.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38, 39, 42 and 45 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I. Claims 1-4, 36-37, 39-41, 43-44 and 46 drawn towards correlating a subscriber unit wherein an installer is prompted for location code having class 379 "TELEPHONIC COMMUNICATIONS", subclass 21 "using portable test set (e.g. handset type)".

Species II. Claims 1, 38, 39, 42 and 45 drawn towards a passive optical network having classification of Class 398 "OPTICAL COMMUNICATIONS", subclass 25 "Determination of communication parameter" or having classification of Class 398 "OPTICAL COMMUNICATIONS", subclass 168 "Passive system".

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4 and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Mulcahy et al (6,002,746 hereinafter Mulcahy).

Regarding claim 1. Mulcahy teaches a method for correlating a subscriber unit to a physical port in a point-to-point or to a point-to-multipoint wire line network (title, abstract) comprising:

prompting an installer to manually input a location code associated with the subscriber unit (col. 7 lines 64-67);

receiving the location code in the subscriber unit (col. 7 lines 64-67);

transmitting the location code via the network to a central repository (col. 7 lines 29-32); and

storing the location code in the central repository to associate the location code with the physical port (col. 8 lines 7-9).

Regarding claim 2. Mulcahy teaches checking the location code for errors before storing (col. 8 lines 11-13);

Upon finding an error, transmitting an instruction to the subscriber unit to indicate error to the installer (col. 8 lines 14-22); and upon finding no errors, storing the location code (col. 7 lines 29-32).

Regarding claim 4. Mulcahy teaches transmitting a site code (col. 7 lines 52-57) and

storing the site code in the central repository (col. 7 lines 29-32, col. 8 lines 7-9).

Regarding claim 39. Mulcahy teaches receiving the location code in the subscriber unit (col. 7 lines 64-67).

Regarding claim 40. Mulcahy teaches prompting an installer to manually input a location code associated with the subscriber unit (col. 7 lines 64-67).

Regarding claim 41. Mulcahy teaches test set used by craftsperson (see 18 figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulcahy et al (6,002,746 hereinafter Mulcahy) in view of Kennedy et al (6,163,594 hereinafter Kennedy).

Regarding claim 3. Mulcahy does not explicitly show prompting the installer to reinput the location code. However, Mulcahy discloses that if an error is detected, the operator can instruct a field engineer (i.e. installer) to perform appropriate operations to correct the error (col. 8 lines 19-22).

Kennedy allows the craftsperson to re-input the location code (col. 2 lines 51-60, col. 3 lines 33-66, col. 7 lines 39-41, col. 10 lines 1-3, lines 29-31, see "reentering the correct directory number" in column 11).

It would have been obvious to any one of ordinary skill in the art at the time of invention to utilize the teachings of Kennedy into the teachings of Mulcahy in order to allow engineer the opportunity to perform appropriate operations to correct the error.

6. Claims 36-37 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulcahy et al (6,002,746 hereinafter Mulcahy) in view of Steinbrenner et al (6,754,310 hereinafter Steinbrenner).

Regarding claim 36. Mulcahy does not explicitly show the location code not previously been correlated with the physical port.

Steinbrenner teaches a telephony interface device for providing status and diagnostic information to a craftsperson wherein the telephony interface device generates and provides voice prompts to aid the craftsperson in understanding or diagnosing the system thereby providing for an interactive telephony test device (col. 10 lines 33-63).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Steinbrenner into the teachings of Mulcahy in order to provide an interactive test set that can accept user input and provide error code voice messages to the craftsperson (see col. 9 lines 8-22 wherein voice prompt played to indicated failure during registration (i.e. not previously correlated)).

Regarding claim 37. Mulcahy does not teach wherein the location code permits identification of network service parameters associated with the subscriber unit.

Steinbrenner teaches a telephony interface device for providing status and diagnostic information to a craftsperson wherein the telephony interface device generates and provides voice prompts to aid the craftsperson in understanding or diagnosing the system thereby providing for an interactive telephony test device (col. 10 lines 33-63). Steinbrenner further teaches (col. 10 line 45) error messages relating to configuration options (i.e. service provisioning).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Steinbrenner into the teachings of Mulcahy in order to provide an interactive test set that can accept user input and provide error code

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voice messages to the craftsperson (see col. 9 lines 8-22 wherein voice prompt played to indicated failure during registration (i.e. not previously correlated)).

Regarding claim 43. Mulcahy does not use the term video.

Steinbrenner teaches a telephony interface device for providing status and diagnostic information to a craftsperson wherein the telephony interface device generates and provides voice prompts to aid the craftsperson in understanding or diagnosing the system thereby providing for an interactive telephony test device (col. 10 lines 33-63). Steinbrenner further teaches (col. 10 line 45) error messages relating to configuration options (i.e. service provisioning). Steinbrenner teaches a telephony interface device for providing status and diagnostic information relating to "alternative media" (col. 1 line 62) including video, voice and high-speed data (col. 2 lines 1-2).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Steinbrenner into the teachings of Mulcahy in order to provide an interactive test set that can accept user input and provide error code voice messages to the craftsperson (see col. 9 lines 8-22 wherein voice prompt played to indicated failure during registration (i.e. not previously correlated)).

Regarding claim 44. Mulcahy does not teach upon detecting an error in the location code, transmitting an indication of the error to the subscriber unit via the network.

Steinbrenner teaches a telephony interface device for providing status and diagnostic information to a craftsperson wherein the telephony interface device

generates and provides voice prompts to aid the craftsperson in understanding or diagnosing the system thereby providing for an interactive telephony test device (col. 10 lines 33-63). Steinbrenner further teaches (col. 10 line 45) error messages relating to configuration options (i.e. service provisioning). Steinbrenner teaches a telephony interface device for providing status and diagnostic information relating to "alternative media" (col. 1 line 62) including video, voice and high-speed data (col. 2 lines 1-2). Steinbrenner teaches locally generated voice prompts can be mixed with network-initiated tones for enhancing the user-experience in the configuration of various telephony or CLASS features (col. 10 lines 60-64).

It would have been obvious for any one of ordinary skill in the art at the time of the invention to utilize the teachings of Steinbrenner into the teachings of Mulcahy in order to provide an interactive test set that can accept user input and provide error code voice messages to the craftsperson (see col. 9 lines 8-22 wherein voice prompt played to indicated failure during registration (i.e. not previously correlated)).

7. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulcahy et al (6,002,746 hereinafter Mulcahy) in view of Abe (6,493,425).

Regarding claim 46. Mulcahy does not teach using a serial number.

Abe teach a method and system for testing a network element within a telecommunications network wherein serial number used to identify element to be tested along with the type of service provided by the network element (abstract, col. 7

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line 60 – col. 8 line 6) allowing specialized circuits such as video-on-demand to be tested easily (col. 1 line 15 – col. 2 line 23).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Abe into the teachings of Mulcahy thereby providing a universal test device that is capable of testing different telecommunication services (see Abe col. 1 lines 34-43), as well as, providing for a test device that is much easier to use (see Abe col. 1 line 67 – col. 2 line 2).

Response to Arguments

8. Applicant's arguments filed 6/17/05 have been fully considered but they are not persuasive.

a) Regarding Applicants remark on page 6, second paragraph, paper dated 6/17/05 wherein Applicants contend that Mulcahy describes a technique for updating routing information for telecommunication lines that have already been activated and established.

The Examiner disagrees. Mulcahy col. 1 line 24 reveals test device used for line provisioning, maintenance and repair. The Examiner notes that independent claim is still general in nature and the definition for SPID alone reads on the general claim language.

Conclusion

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Friday, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached at (571) 272-7499. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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